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PATENT APPLICATION

ATTORNEY DOCKET NO. 200206588-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Gerardo Orozco-Abndis

Confirmation No.: 1561

Application No.: 10/636,120

Examiner: Ghatt, Dave A.

Filing Date: August 7, 2003

Group Art Unit: 2854

Title: IMAGE CAPTURE DEVICE WITH A TELESCOPIC HINGE

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on February 2, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Gerardo Orozco-Abundis Confirmation No.: 1561
Serial No.: 10/636,120
Filing Date: August 7, 2003
Group Art Unit: 2854
Examiner: Ghatt, Dave A.
Title: IMAGE CAPTURE DEVICE WITH A TELESCOPIC
HINGE
Docket No.: 200206588-1

MAIL STOP: APPEAL BRIEF PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed November 2, 2005. Applicant filed a Notice of Appeal on February 2, 2006. Applicant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from the inventor recorded on December 23, 2003, in the Assignment Records of the United States Patent and Trademark Office at Reel 014827, Frame 0858. The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-11, 13-15 and 17-18 stand rejected, and Claims 12 and 16 stand objected to, pursuant to an Office Action mailed November 2, 2005. Claims 1-11, 13-15 and 17-18 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Office Action dated November 2, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 1 are directed toward an image capture device (10) comprising a housing (12) and at least one telescopic hinge (40) operable to couple a lid (20) to the housing (12) (at least at page 2, paragraphs 0010 and 0011, page 3, paragraphs 0012-0014, figures 1 and 2).

Embodiments of the present invention as defined by independent Claim 11 are directed toward an image capture device (10) comprising a lid (20), a housing (12) and at least two telescopic hinges (40) each having a plurality of extensible segments (42, 44, 46) where the at least two telescopic hinges (40) are pivotally coupling the lid (20) to the housing (12) (at least at page 2, paragraphs 0010 and 0011, page 3, paragraphs 0012-0014, page 4, paragraph 0017, figures 1 and 2).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-9, 11, 13-15, 17 and 18 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 4,150,896 issued to Wakeman (hereinafter “Wakeman”).
2. Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wakeman in view of U.S. Patent No. 3,832,937 issued to Moore et al. (hereinafter “Moore”).

ARGUMENT

A. Standard

1. 35 U.S.C. § 102

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

2. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument

1. First Ground of Rejection (Claims 1-9)

Claims 1-9 were rejected under 35 U.S.C. §102(e) as being anticipated by *Wakeman*. Of the rejected claims, Claim 1 is independent. Applicant respectfully submits that independent Claim 1 is patentable over the *Wakeman* reference and, therefore, Claims 2-9 that depend therefrom are also patentable.

In the Office action, the Examiner states that *Wakeman* teaches the claimed invention (as recited by Claim 1) (Office Action, page 3). Applicant respectfully disagrees. *Wakeman* appears to disclose a support member 25 for coupling a cover 27 to a copier housing 21 where the support member 25 comprises a hinge 35, a support arm 30, a rectangular arm 33 (coupled to the cover 27), and a positioning rod 31 (*Wakeman*, column 3, lines 45-51, figures 1, 5 and 6). *Wakeman* also appears to disclose that the

positioning rod 31 is slidably inserted into a housing hole 32 formed in the copier housing 21 to enable variable positioning of the cover relative to the copier housing of *Wakeman* (*Wakeman*, column 3, lines 52-5-, figures 5 and 6).

Independent Claim 1 recites “a housing” and “at least one telescopic hinge operable to couple a lid to said housing” (emphasis added). At least because Applicant’s Claim 1 separately recites a “telescopic hinge” and a “housing,” the support member 25 of *Wakeman* must be construed in the *Wakeman* reference separate from the copier housing of *Wakeman*. In contrast, the Examiner appears to consider a portion of the copier housing 21 of *Wakeman* to be both the “housing” and the “telescopic hinge” recited by independent Claim 1, which is improper. In the Office Action, the Examiner states:

[A]t least one telescopic hinge, shown generally at 35
(comprising elements 30, 31, 33, segment A).

(Office Action, page 3 (referring also to the Examiner’s marked up sketch included on page 4 of the Office Action)). The element 35 referred to by the Examiner appears to be directed toward the hinge element of the support member 25 of *Wakeman* (*Wakeman*, column 3, lines 65-67, figure 6). Further, as discussed above, the elements 30, 31 and 33 of *Wakeman* referred to by the Examiner appear to form part of the support member 25. However, the “segment A” referred to by the Examiner is clearly not part of the support member 25 of *Wakeman*. To the contrary, despite the Examiner’s labeling of the aforementioned “segment A” as a “hinge segment A,” such element appears to be nothing more than a sleeve bearing installed in the copier housing 21 of *Wakeman* (*Wakeman*, figure 6). Thus, the “segment A” does not form part of the support member 25 of *Wakeman*. Moreover, the support member 25 cannot independently perform any telescopic function. The support member 25 of *Wakeman*, which couples the cover of *Wakeman* to the copier housing of *Wakeman* is not, by itself, “a telescopic hinge” as recited by independent Claim 1. The support member 25 of *Wakeman* appears to be formed as a single, rigid body that is not “telescopic” nor does it appear to be capable of providing any telescoping function.

Thus, Applicant respectfully submits that *Wakeman* does not disclose or even suggest “at least one telescopic hinge” coupling a lid to a housing as recited by independent Claim 1. Therefore, for at least this reason, Applicant submits that *Wakeman* does not anticipate independent Claim 1. Accordingly, Applicant respectfully submits that independent Claim 1, and Claims 2-9 that depend therefrom, are patentable over the *Wakeman* reference.

2. First Ground of Rejection (Claims 11, 13-15, 17 and 18)

Claims 11, 13-15, 17 and 18 were rejected under 35 U.S.C. §102(e) as being anticipated by *Wakeman*. Of the rejected claims, Claim 11 is independent. Applicant respectfully submits that independent Claim 11 is patentable over the *Wakeman* reference and, therefore, Claims 13-15, 17 and 18 that depend therefrom are also patentable.

With respect to independent Claim 11, the Examiner states that “*Wakeman* shows two telescopic hinges, each having a plurality of extensible segments” (Office Action, page 5). Applicant respectfully disagrees.

Independent claim 11 recites “a lid,” “a housing” and “at least two telescopic hinges, each having a plurality of extensible segments . . . pivotally coupling said lid to said housing.” As discussed above, at least because Applicant’s Claim 11 separately recites “at least two telescopic hinges” and “a housing,” the support member 25 of *Wakeman* (which coupled the lid of the *Wakeman* device to the housing 21 of the *Wakeman* device) must be construed in the *Wakeman* reference separate from the copier housing of *Wakeman*. In contrast, the Examiner appears to consider a portion of the copier housing 21 of *Wakeman* to be both the “housing” and the “telescopic hinges” recited by independent Claim 11, which is improper. For example, as discussed above and referring to page 4 of the Office Action, the Examiner appears to consider a sleeve bearing installed in the copier housing 21 of *Wakeman* as part of the support member 25 of *Wakeman*, which is improper. To the contrary, the sleeve bearing (identified as “hinge

segment A” in the Examiner’s self-label sketch) clearly does not form part of the support member 25 of *Wakeman*. Thus, the support member 25 of *Wakeman*, which couples the cover of *Wakeman* to the copier housing of *Wakeman* is not, by itself, a “telescopic hinge” as recited by independent Claim 11, nor does the support member 25 of *Wakeman* include “a plurality of extensible segments” as recited by Claim 11. The support member 25 of *Wakeman* appears to be formed as a single, rigid body that is not “telescopic” nor does it appear to be capable of providing any telescoping function. Thus, Applicant respectfully submits that *Wakeman* does not disclose or even suggest “at least two telescopic hinges” coupling a lid to a housing as recited by independent Claim 11. Therefore, for at least this reason, Applicant submits that *Wakeman* does not anticipate independent Claim 11.

Accordingly, Applicant respectfully submits that independent Claim 11 is clearly patentable over the *Wakeman* reference and, therefore, Claims 13-15, 17 and 18 that depend therefrom, are also patentable.

3. Second Ground of Rejection (Claim 10)

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Wakeman* in view of *Moore*. Claim 10 depends from independent Claim 1. As discussed above, Claim 1 is patentable over the *Wakeman* reference. For example, *Wakeman* does not disclose or even suggest a “telescopic hinge operable to couple a lid to [a] housing” as recited by Claim 1. Therefore, for at least this reason, Applicant respectfully submits that Claim 10 is patentable over the cited references.

Moreover, Claim 10 depends from Claim 9 which recites “at least another segment of said at least one telescopic hinge is slidably engaged with said at least one segment [of the telescopic hinge],” and Claim 10 recites “a third segment of said at least one telescopic hinge is slidably engaged with said at least another segment.” Applicant respectfully submits that there is no motivation or suggestion to combine reference teachings as proposed by the Examiner. For example, the Examiner appears to cite

Moore for the sole purpose that it purportedly teaches “a telescopic device similar to that taught by *Wakeman*” and states that it would have been obvious to “provide a third segment as taught by *Moore* in the apparatus of *Wakeman*, in order to increase the expansion capabilities” (Office Action, page 6). Applicant respectfully disagrees. As discussed above in connection with independent Claims 1 and 10, the support member 25 of *Wakeman* is not “telescopic.” Further, the support member 25 of *Wakeman* does not include any slidable segments. To the contrary, what the Examiner appears to consider a slidable extension is clearly the sleeve bearing disposed in the housing of *Wakeman*, which is clearly not part of the support member 25 of *Wakeman*.

Moreover, *Wakeman* appears to teach away from the proposed combination. For example, as discussed above in connection with independent Claims 1 and 10, the support member 25 of *Wakeman* includes a post (positioning rod 31) that is disposed into the opening formed in the housing 21 of the *Wakeman* device (*Wakeman*, figures 5 and 6). Applicant respectfully submits that providing any extension in the *Wakeman* device as proposed by the Examiner appears unnecessary and would add additional cost to the *Wakeman* device at least because the proposed “increase[ed] . . . expansion capabilities” as suggested by the Examiner appears to be easily obtainable in the *Wakeman* device by increasing the length of the post (positioning rod 31) of *Wakeman*. Thus, the proposed reason offered by the Examiner for combining reference teachings clearly appears to be based on Applicant’s disclosure, which is improper.

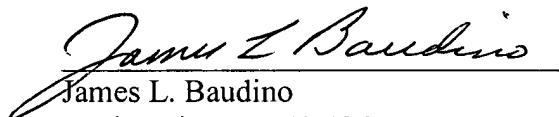
Therefore, for at least these reasons, Applicant respectfully submits that Claim 10 is patentable over the cited references.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,



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Date: 3-28-06

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CLAIMS APPENDIX

1. An image capture device, comprising:
a housing; and
at least one telescopic hinge operable to couple a lid to said housing.

2. The image capture device of claim 1, wherein said at least one telescopic hinge releasably couples said lid to said housing.

3. The image capture device of claim 1, further comprising at least one slot in said housing, said at least one slot operable to engage with at least a portion of said at least one telescopic hinge to prevent inadvertent decoupling of said at least one telescopic hinge from said housing.

4. The image capture device of claim 1, wherein said housing comprises at least one recess corresponding to said at least one telescopic hinge.

5. The image capture device of claim 1, wherein said housing comprises at least one recess, each of said at least one telescopic hinge being inserted into a corresponding one of said at least one recess to couple said lid with said housing.

6. The image capture device of claim 1, wherein said at least one telescopic hinge comprises a plurality of segments.

7. The image capture device of claim 1, wherein said at least one telescopic hinge comprises at least one segment slidably engaged with at least another segment.

8. The image capture device of claim 1, wherein at least one segment of said at least one telescopic hinge is adapted to be disposed in a recess of said housing.

9. The image capture device of claim 8, wherein at least another segment of said at least one telescopic hinge is slidably engaged with said at least one segment.

10. The image capture device of claim 9, wherein a third segment of said at least one telescopic hinge is slidably engaged with said at least another segment.

11. An image capture device, comprising:
a lid;
a housing; and
at least two telescopic hinges, each having a plurality of extensible segments, said at least two telescopic hinges pivotally coupling said lid to said housing.

13. The image capture device of claim 11, wherein a first segment of said plurality of segments comprises a ledge near an end of said first segment.

14. The image capture device of claim 13, wherein said ledge surrounds an opening at said end.

15. The image capture device of claim 13, wherein a second segment of said plurality of segments comprises a latching member operable to engage with said ledge.

17. The image capture device of claim 11, wherein said at least two telescopic hinges releasably couple said lid to said housing.

18. The image capture device of claim 11, wherein a segment of said plurality of segments comprises a channel operable to accept a pin to pivotally couple said lid to said hinge.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None